No. 80-155

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM 1980

AMSTAR CORPORATION,

Petitioner,

v.

DOMINO'S PIZZA, INC.; ATLANTA PIZZA, INC.; PIZZA ENTERPRISES, INC.; PIZZA SERVICES, INC.; and HANNA CREATIVE ENTERPRISES, INC.,

Respondents.

REPLY TO BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Respondent DPI's Opposition to Amstar's Petition points up the importance of a resolution of the issues involved here to all trademark owners and users.* There is a compelling need for this Court to provide guidance as to the meaning of "likelihood of confusion" in sponsorship or association circumstances—the test of trademark infringement under the Lanham Trademark Act of 1946, 15 U.S.C. § 1051 *et seq.*

There is no substantial dispute between the parties as to the evidentiary facts. The District Court and the Court of Appeals essentially agreed on the facts. The disagreement relates to the ultimate conclusion—presence or

* By way of example, Sun-Kist Growers, Inc. has stated its intent to file a brief *amicus curiae* should this Petition be granted.

absence of likelihood of confusion as to sponsorship or affiliation—to be drawn from those evidentiary facts. This Court need not review all the evidence to resolve the disagreement, as DPI alleges (Opp. p. 4).

As trademark disputes typically are factual in nature, pointed out so cogently by DPI (Opp. p. 5), this Court's interpretation of the Lanham Act, resolution of conflicts between and within the circuits as to the protection which should be accorded to trademarks and guidance as to which evidentiary facts should be given weight in reaching the ultimate conclusion, becomes all that more necessary. Here, a writ of certiorari should issue because:

> (a) It is essential for this Court to interpret the meaning of likelihood of confusion, particularly likelihood of confusion as to affiliation or sponsorship, a task not undertaken by this Court since 1946.
>
> (b) It is necessary for this Court to resolve the conflict between the Court of Customs and Patent Appeals (and its subsidiary tribunal) and the Fifth Circuit as to the scope of protection to be accorded Amstar's famous DOMINO trademark.
>
> (c) It is necessary for this Court to resolve the differing judicial interpretations of the weight to be accorded such evidentiary facts as the fame of the owner's trademark; the relationship of the respective goods; the existence of third-party registrations; and the existence of third-party uses (see Petition pp. 7-14).

These issues may be resolved without any attention to the record beyond the two opinions below. The ultimate conclusion may be reviewed regardless of whether likelihood of confusion is a question of law or fact or both, a standard of review which in itself is subject to a conflict among the circuits (see A75).

Rather than address the reasons for granting the writ, DPI's Opposition seeks to create the "straw man" of several factual issues, arguing that this Court should not resolve those issues (Opp. p. 9). For example, DPI lists many third-party registrations allegedly affecting protection of the DOMINO mark (Opp. p. 6 and Appendix B). There is no dispute as to the existence of these registrations (although DPI carefully does not list the dates on which the very old registrations issued or state whether the registrations are still extant). These are matters of public record. The undisputed fact is that *not one* of these registrations has issued since the Lanham Act of 1946 for any food product and is still in existence. These registrations on their face either issued prior to the Lanham Act and are long expired, or are for wholly unrelated products, such as concrete docks for mooring boats.

The question to be resolved is whether such "ancient" and irrelevant third-party registrations are now to be considered in determining the scope to be accorded Amstar's famous mark. The Fifth Circuit previously held that third-party registrations have no such effect. *Turner* v. *HMH Publishing Co.*, 380 F.2d 224, 228 (5th Cir.), *cert. denied* 389 U.S. 1006 (1967). But, in the decision below, the Fifth Circuit held, without even citing *Turner*, that "such extensive third-party . . . registration of 'Domino' can [not] be so readily dismissed" (A79) and that "the third-party . . . registrations discussed above merely limit the protection to be accorded plaintiff's mark outside the uses to which plaintiff has already put its mark" (A80). This is just one error in application of the Lanham Act which must be cured with the guidance of this Court. If not, this important legal issue will continue to be the subject of extensive conflict.

As another example of a supposed factual issue, DPI contends that sugar and pizza "are highly dissimilar prod-

ucts" (Opp. p. 5-6). There is no factual dispute that these products are dissimilar. It likewise is not disputed that both are food products sold for human consumption. And, it is also not disputed that both parties sell other food products. Amstar sells DOMINO salt, pepper, ketchup, mustard, jams and jellies, salad dressings, beverage mixes and other foods (A72). DPI sells DOMINO'S soft drinks, pizza ingredients and toppings, including a sugar and salt mix (Opp. p. 2).

The question to be resolved is whether use of the same mark DOMINO for different food products is likely to cause confusion. The C.C.P.A., in *American Sugar Ref. Co. v. Andreassen*, 296 F.2d 783 (C.C.P.A. 1961), held that it is, even where both food products are not sold for human consumption. The Fifth Circuit also previously held that it is, so long as both products are consumable. *Beef/Eater Restaurants, Inc. v. James Burrough Ltd.*, 398 F.2d 637, 639 (5th Cir. 1968). But, in the decision below, the Fifth Circuit held, without citing either *Andreassen* or *Beef/Eater*, that "about the only things they have in common are that they are edible" and that is not sufficient similarity to result in likelihood of confusion (A84). Again this conflict in interpretation of federal law must be resolved by this Court.

Where a mark is "distinctive, well-known" (A80), "arbitrary" (A82), and "deserving substantial protection" (A92), as the Fifth Circuit found respecting Amstar's DOMINO mark, it is entitled to protection against use of the virtually identical mark for related, but non-competitive goods. These two elements—similarity in the marks and the goods—are the only essential similarities required to establish trademark infringement as provided by the Lanham Act, 15 U.S.C. § 1114(1). The other elements listed by DPI simply are "make-weights" (Opp. pp. 6-8 and

Appendix A). This Court should adopt this generally accepted principle to guide the lower courts in their application of the Lanham Act. Otherwise, they will continue to err in their interpretations.

Respectfully submitted,

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